

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lee M. Amaitis, et al.
Application No. : 10/667,923 Confirmation No. : 1611
Filed : September 22, 2003
For : SYSTEM AND METHOD FOR BETTING ON A
PARTICIPANT IN A GROUP OF EVENTS
Group Art Unit : 3714
Examiner : Christian E. Rendon

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request review of the Final Rejection of November 4, 2008 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets. Note that no more than five (5) pages of reasons have been provided.

I. The Examiner Fails to Establish a Prima Facie Case of Lack of Enablement

The Examiner rejects claims **8** and **21** under 35 U.S.C. § 112, first paragraph, for lack of enablement based on the assertion that the “limitation requires using the same index number to define three different ranges: greater than, less than however a third range is mathematically impossible.” Office Action, pg. 2. Because the Examiner’s rejection of the claims is based on limitations not recited by the claims, the Examiner fails to establish a *prima facie* case of lack of enablement. Specifically, the Examiner’s rejection of the claims is based on the assumption that given an index number, one must define two of the three ranges as greater than the index number and less than the index number, making it mathematically impossible to define the third range. However, claims **8** and **12** do not recite such limitations. On the contrary, given an index number, one skilled in the art can determine numerous ranges (see e.g., Specification pg. 13, lines 10-19).

II. The Examiner Fails to Establish a Prima Facie Case of Anticipation

The Examiner rejects claims **1, 3-4, 9-13, 15-17, and 22-26** under 35 U.S.C. § 102(b) as being anticipated by Simon et al., U.S. Patent No. 7,172,508 (hereinafter Simon).

MPEP § 2131 sets forth an Examiner’s duties under § 102:

A claim is anticipated only if **each and every element as set forth in the claim** is found, either expressly or inherently described, in a single prior art reference.... The identical invention must be shown in **as complete detail as is contained in the ... claim**. (emphasis added).

The Examiner fails to show that Simon discloses each and every element of the claims.

a. Independent Claims 1 and 17

Independent claim **1**, and similarly independent claim **17**, recites in part:

for each of the plurality of events, a plurality of units are allocated among participants according to a respective finishing position of each participant.

In rejecting claims **1** and **17** regarding these limitations, the Examiner asserts:

Furthermore, placing a bet on the final score and the winner of the game is considered equivalent towards a plurality of units allocated among participants respective to a finishing position. **In other words, the finish position of each participant is the standing of an athlete at the end of a game.** Office Action, para. 4, pg. 4; and pg. 10 (bold emphasis added).

Notably, the Examiner equates “*units*” as recited by the claims to “points earned or scored by a participant or team over the course of” a sporting event(s), as allegedly disclosed by Simon. Office

Action, para. 3, pgs. 3-4; and pg. 10. Accordingly, the Examiner's rejection of the claims is based on the rationale that the above limitations are equivalent to the finish position of each participant being based on the total number of points earned or scored by the participant at the end of the game. However, this is not what claims **1** and **17** recite. Again, to establish a *prima facie* case of anticipation, the identical invention must be shown in as complete detail as is contained in the claim. Because the Examiner fails to show that Simon discloses each and every element of claims **1** and **17**, the Examiner fails to establish a *prima facie* case of anticipation of these claims, and the claims that depend there from.

b. Dependent Claims 3-4

Claim **3** (and similarly claim **4**), when read in combination with claim **1**, recites:

... a bet that the total number of units earned by a particular jockey over a course of a plurality of horse races will fall within a first range of numbers, wherein: ...

for each of the plurality of horse races, a plurality of units are allocated among jockeys according to a respective finishing position of each jockey.

Contrary to any apparent assertions by the Examiner (see Office Action, para. 5, pg. 4), Simon col. 18, lines 5-27 does not disclose such limitations. Furthermore, the Examiner, through unsubstantiated assertions as to what Simon may "inherently incorporate[]" (see Office Action, para. 5, pg. 4), fails to articulate how Simon discloses such limitations. Because the Examiner fails to show that Simon discloses each and every element of claims **3** and **4**, the Examiner fails to establish a *prima facie* case of anticipation of these claims.

c. Dependent Claims 9 and 22

In rejecting dependent claims **9** and **22** (see Office Action, para. 6, pg. 5), the Examiner fails to make any reference to the limitations of these claims including, for example, "*determining a number of units earned by the particular participant based at least on the finishing position of the particular participant in that event.*" On the contrary, the Examiner makes various assertions unrelated to the claims about how the prior art allegedly discloses placing bets on the total of points scored by both teams, on a team's finishing position, and on a team's standing in a sports league. Because the Examiner fails to articulate how Simon discloses each and every element of claims **9** and **12**, the Examiner fails to establish a *prima facie* case of anticipation of these claims.

III. The Examiner Fails to Establish a Prima Facie Case of Obviousness

The Examiner rejects claims **2, 5-8, 10-11, 14, 18-21, 23-24, and 27-52** under 35 U.S.C. § 103(a) as being unpatentable over Simon, and/or combinations of Simon in view of Friedman, U.S. Patent No. 6,126,543 (hereinafter Friedman), Ken Daly, “Handicapping the Race ...” (hereinafter Daly), and/or McNutt et al. U.S. Patent No. 6,837,791 (hereinafter McNutt).

In a determination of obviousness, the Examiner must support all factual findings with substantial evidence of record. In re Zurko, 258 F.3d 1379, 1383-84 and 86 (Fed. Cir. 2001); MPEP §§ 2141(II) and 2144.03. The Supreme Court has reiterated that mere conclusory statements are insufficient on which to base a conclusion of obviousness. KSR Int’l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740-42 (S.Ct. 2007). Because the Examiner fails to provide evidence of record, let alone substantial evidence of record, to support the rejection of the claims, the Examiner fails to establish a *prima facie* case of obviousness of the claims.

a. Dependent Claims 14 and 27

In rejecting dependent claims **14** and **27**, the Examiner makes purely conclusory assertions, unsupported by any evidence of record, regarding purported motivations for modifying Simon in the manner recited by the claims (e.g., “**it is only logical** to allow a player the opportunity to back out of a wager ...” and “**it is only logical** for the system to return only a portion of the player’s money...”). Office Action, para. 8, pgs. 5-6 (bold emphasis added). Because the Examiner fails to provide any evidence of record to support such assertions, the Examiner fails to establish a *prima facie* case of obviousness of these claims.

b. Dependent Claims 5 and 18

In rejecting claims **5** and **18**, the Examiner refers to Simon col. 5, lines 47-49 as a basis for a purported motivation (i.e., that “to include ... elements [of] Friedman into Simon[] ... [would] further improv[e] a system of conducting a sport game ...”) for combining alleged features of Simon and Friedman in the manner recited by the claims. Office Action, para. 10, pg. 6. While the cited portion of Simon refers to Friedman, the cited portion of Simon fails to make any reference to such a motivation. Rather, the Examiner’s purported motivation is purely conclusory and thereby insufficient to establish a *prima facie* case of obviousness of these claims.

c. Dependent Claims 6-8 and 19-21

In rejecting dependent claims **6-8** and **19-21**, the Examiner fails to make any reference to the limitations of these claims including, for example, a “*bet that the total number of units earned by the particular participant ...will fall within a third range of numbers/a fourth range of numbers.*” Furthermore, the Examiner, through unsubstantiated assertions as to what Simon may “inherently incorporate[]”(see Office Action, para. 11, pgs. 6-7), fails to articulate how Simon discloses such limitations. Because the Examiner fails to show that Simon discloses all the limitations of these claims, the Examiner fails to establish a *prima facie* case of obviousness.

d. Independent Claims 28 and 42

In rejecting independent claims **28** and **42**, the Examiner asserts that Daly par. 8, lines 3-4 discloses the limitations directed at “*a bet that the number of units earned by that participant ... will exceed a[n] ... index number before the number of units earned by any other of the plurality of participants exceeds the ... index number.*” (Office Action, para. 13, pg. 7). Contrary to the Examiner’s assertions, the cited portion of Daly does not disclose such limitations. In further rejecting these claims the Examiner asserts that Daly discloses such limitations based on a purported definition of “chase” and based on a series of conclusory assertions, none of which the Examiner supports with any evidence from Daly. Office Action, pgs. 10-11. Because the Examiner fails to show that Daly discloses the above limitations of claims **28** and **42**, the Examiner fails to establish a *prima facie* case of obviousness of these claims, and claims depending there from.

In further rejecting claims **28** and **42**, the Examiner fails to make reference to the limitations directed at “*determining the total number of units earned by that participant based at least in part on the positioning of that participant in at least a portion of the plurality of events*” Office Action, para. 12-13, pg. 7. Nonetheless, Applicants proceed under the assumption that the Examiner asserts that Simon discloses such limitations based on the same rational the Examiner used in asserting that Simon discloses “*a plurality of units are allocated among participants according to a respective finishing position of each participant,*” as claims **1** and **17** recite. For similar reasons set forth above for claims **1** and **17**, the Examiner fails to show that Simon discloses such limitations of claims **28** and **42** and as such, fails to establish a *prima facie* case of obviousness of these claims, and claims depending there from.

In further rejecting claims **28** and **42**, the Examiner asserts that one skilled in the art would be motivated to combine alleged features of Daly and Simon based on the rational that because

“Simon places no limitations on the type ... of a betting line ... allowed to [an] administrator,” it would be “obvious for an administrator ... to allow their gamblers to place wagers on whom of the baseball player would break the home run record.” Office Action, para. 13, pg. 7. The Examiner’s purported motivation for combining the references is purely conclusory, unsupported by evidence of record, and thereby insufficient to establish a *prima facie* case of obviousness.

e. Dependent Claims 2, 11, and 24

Claim 2, for example, when read in combination with claim 1, recites:

... a bet that the total amount of money earned by a particular participant over a course of a plurality of events will fall within a first range of numbers.

Contrary to any apparent assertions by the Examiner (see Office Action, para. 20, pg. 9), McNutt col. 6, lines 40-48 and col. 23, line 61 do not disclose such limitations. Furthermore, the Examiner fails to articulate how McNutt may disclose such limitations in that the Examiner describes several alleged features of McNutt without making reference to such limitations.

In further rejecting claims 2, 11, and 24, the Examiner asserts that one skilled in the art would be motivated to combine alleged features of McNutt and Simon based on the conclusory assertion that this would “fill in the blanks.” Office Action, para. 20, pg. 9. The Examiner’s purported motivation is purely conclusory and thereby insufficient to establish a *prima facie* case of obviousness.

f. Dependent Claims 10 and 23

In rejecting dependent claims 10 and 23, the Examiner makes various unsubstantiated and conclusory assertions as to features that Simon “inherently incorporates,” and makes further conclusory assertions about modifying Simon in the manner recited by the claims without providing any evidentiary basis for such modifications. Because the Examiner’s rejection of the claims is based on purely conclusory assertions, the Examiner fails to establish a *prima facie* case of obviousness.

IV. Conclusion

For the foregoing reasons, withdrawal of the rejection is respectfully requested.

Respectfully submitted,

May 4, 2009
Date

 /Glen R. Farbanish/
Glen R. Farbanish
Reg. No. 50,561
(212) 294-7733/phone